(USPN 4,049,256). Finally, claims 85-88 were rejected over Fredlund, Johnson and Robertson (USPN 6,505,534).

The Restriction Requirement

Applicants elect with traverse Group I.

The Objection to the Abstract

Applicants have amended the Abstract. Withdrawal of the objection is requested.

The Section 103 Rejections

Claims 1-11 were rejected under Section 103(a) as unpatentable over Fredlund (USPN 5,666,215) and Johnson (USPN 6,052,670). The Office Action noted that

Regarding claim 1, Fredlund discloses a method of distributing image prints printed on a plurality of printers to a plurality of recipients, the method comprising:

Receiving an order specifying one or more recipients and, for each specified recipient, a set of one or more images associated with that recipient (column 5, lines 38-47 and column 6, lines 36-37); and

for each recipient specified by the order, separating the images associated with the recipient into at least one printable unit of images (column 7, lines 18-30 and column 2, lines 4244). However, Fredlund discloses sending multiple orders to plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses in column 22, lines 60-62, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". Therefore, it would have been obvious to a person skilled in the art, at the time of invention to specify a plurality of recipients, and for each specified recipients, a set of one or more images associated with that recipient to streamline the process.

Applicants respectfully traverse the rejection. Fredlund relates to a system for remotely selecting photographic images where a photographic image can be viewed at a customers location on her personal computer and images selected for initial printing, reprinting and ordering related image services. Photographic negatives are provided to a scanner to obtain image data. The image data is manipulated to provide a positive image of the photographic

negatives and sent to the customer's personal computer. The desired prints are then selected and order information is provided, based on the positive image as displayed on the display of the personal computer. The order information is recorded to allow the desired prints and services to be created and the resulting order is sent to a designated addressee.

Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Johnson et al. reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference Fredlund so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

Applicant traverses the comparison. Here, Johnson shows an object oriented framework mechanism for an electronic catalog. The electronic catalog framework includes core classes and extensible classes that allow a framework consumer to implement a desired electronic catalog. As discussed on Col. 17, lines 16-49, the electronic catalog allows users to select from a common list of products to all customers.

Referring to FIG. 9, an example of electronic catalog framework 870 (FIG. 8) in accordance with the preferred embodiment performs steps that comprise a method 900 for defining an electronic catalog. The first step is to setup the components that are needed to define and use the desired electronic catalog (step 910). This step builds and maintains critical objects in the electronic catalog, such as product objects, the catalog object, order objects, and customer objects. Once one or more catalogs are defined and ready to use, a customer may interact with the electronic catalog to browse for product information and to place an order. To start using an electronic catalog, a user typically selects the desired catalog (step 920). For an on-line catalog, this selection may be made by the user clicking a link that identifies which catalog to use. Next, the customer may

enter information that identifies the customer to the electronic catalog (step 930). This information may include a user password or authorization code if use of the catalog is restricted to authorized users. The electronic catalog then validates the customer information, if required (step 940). If the customer is authorized to access the electronic catalog, the catalog cover is then displayed to the user (step 950). The cover page may include advertisements for special sales items, or any other appropriate information that needs to be conveyed to a user. The cover page will typically include a link that will open the catalog (step 960) when selected by a user. Once the catalog has been opened, the catalog may process any user request that is supported by the catalog (step 970). Examples of some suitable user requests are: finding a product; jumping to a catalog index; jumping to a listing of the contents of the catalog; jumping to a table of contents; and creating a pick list. Once the pick list is complete, the user may submit the pick list to create an order (step 980).

However, this shopping modality is different that that for photo printing, where digital images and image-based products are unique to each user. Each user uploads images in his or her account. The images in each user's account are completely personalized to the user. The image products ordered by each user are also uniquely different among users because the image-based products comprise unique images uploaded by the users. The users have to personally select their digital images for the image-based products they order. An electronic catalog that can be viewed and selected by all users does not simply exist in photo printing in the instant application. Applying Johnson's teaching to Fredlund would not have resulted in an operable system since there is no common list of products/services such as those found in a catalog.

A catalog is geared to selling standardized products that can be catalogued. In contrast, in the photography field, each image product is unique and individualized. The concept of a catalog selling custom/individualized images in single quantity is inapposite. Hence, Fredlund does not allow a user to order for multiple recipients at different addresses in one order wherein each recipient can receive different photo products in such an order. Similarly, Johnson's electronic catalog does not describe such method of submitting one order having different recipients wherein each recipient receives different products. One skilled in the art would not have combined a catalog system such as Johnson with the Fredlund catalog to provide uniquely individualized photo products as in the claimed invention.

The combination suggested in the office action was done using selective hindsight. There is no suggestion or motivation in Johnson to modify Fredlund to arrive at a computer-

implemented method of distributing image prints to a plurality of recipients by receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipient.

Applicant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of claim 1 of a single order with multiple recipients. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson reference, or knowledge of those skilled in the art, for a single order specifying a plurality of recipients, *prima facie* obviousness of claim 1 (and dependent claims) has not been established. As such, it is respectfully requested that the § 103(a) rejection of independent claims (and dependent claims) be withdrawn and the claims be allowed.

Claims 12-24, 29-55, 59-76 and 89 were rejected as unpatentable over Fredlund, Johnson, and Cok (USPN 6,157,436). Cok shows an image printing system for generating multiple printed image copies in response to an order. In Cox, a processor can divide the order into multiple sub-orders for respective image printers, each sub-order having a sub-order header which includes a unique order identification and an indication of the number of copies of the image to be printed by the corresponding printer. A plurality of image printers are connected to the processor, to each receive a corresponding sub-order and print the corresponding sub-order header, and the numbers of image copies indicated in that header. However, Cok still does not show the missing elements of the independent claims raised above. Hence, with respect to the dependent claims, they are allowable because they depend from allowable independent claims.

With respect to independent claim 35, the references Fredlund, Johnson, and Cok do not teach or disclose receiving an order specifying one or more recipients and, for each specified recipient, a set of digital content associated with that recipient. Moreover, the references do not show for each recipient specified by the order, separating the digital content associated with the recipient into at least one generatable unit of digital content; and for each generatable unit of digital content, generating a physical manifestation of the unit of digital content. Hence, independent claim 35 is patentable over Fredlund, Johnson, and Cok.

For claim 35, the Office Action merely noted that "argument analogous to those presented for claims 1-3 respectively, are applicable." However, as discussed above, Fredlund and Johnson cannot render the claims obvious. Withdrawal of the rejection is requested and allowance of claim 35 and those dependent therefrom is requested.

With respect to independent claim 43, the references Fredlund, Johnson, and Cok singly or in combination do not show a print distribution system with a plurality of printers; a front-end computer sub-system for receiving an order specifying one or more recipients and, for each specified recipient, a set of one or more images associated with that recipient; and a scheduler, connected to the front-end computer sub-system and the plurality of printers, that for each recipient specified by the order (a) separates the images associated with the recipient into at least one printable unit of images, and (b) designates a printer on which each printable unit is to be printed.

The Office Action asserts that Fredlund's computer 26 corresponds to the front-end computer system and print server 104 corresponds to the scheduler. Fredlund's Col. 7, lines 19-30 shows the relationship between the computer 26 and the print server 104 as follows:

> the computer 26 also controls an image-capable print server 104 which is connected to a variety of printers. The printers may include for example a digital silver halide printer 106 for exposing conventional silver halide photographic paper to produce enlargements 107, a color thermal printer 108, or a large format color ink jet printer 110 for making poster sized prints. Also connected to computer 26 is a CD writer 113 for producing Photo CD's 125. Computer 26 can manipulate scanned high resolution image files from mass storage 28 such that the desired prints or Photo CD™ optical disc, or image bearing articles are created.

However, Fredlund does not show the scheduler, connected to the front-end computer sub-system and the plurality of printers, that for each recipient specified by the order (a) separates the images associated with the recipient into at least one printable unit of images, and

(b) designates a printer on which each printable unit is to be printed. Similarly, Fredlund's Col. 5, lines 35-51 does not show the scheduler. Rather, Fredlund teaches that:

> If there are more images in the file than can be shown in the column 52, the other images can be displayed by activating a scroll bar 54 to scroll the images in the column. To select one of the images from the digital image file, the customer selects the desired print size and quantity in area 76. Display area 56 assumes the correct aspect ratio for the desired final print size. The customer then identifies one of the images using a standard drag and drop computer interface or set-top box selection mode, for example by clicking on one of the images with a mouse or trackball and dragging it into the large display area 56, or by entering the desired frame number on a remote control device if the program is implemented via a set-top box. The customer can thereby use the computer data entry means to select one at a time the images he or she desires to have printed and desired services relating to each selected image. In this manner, a simple, non-intimidating display can be used to enter all necessary order information. Other image related services may include Photo CD's, image bearing items such as coffee mugs and T-shirts, and poster sized prints.

Here, Fredlund does not show the scheduler, connected to the front-end computer sub-system and the plurality of printers, that for each recipient specified by the order (a) separates the images associated with the recipient into at least one printable unit of images, and (b) designates a printer on which each printable unit is to be printed. In sum, independent claim 43 is patentable over Fredlund, Johnson, and Cok. Allowance of claim 35 and those dependent therefrom is requested.
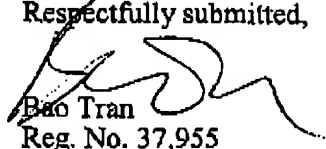
USL, 8, L-4563
Col.8,

CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,

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